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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,144	01/25/2001	Spencer A. Rathus	660-018	8423

7590 07/15/2003
Ward & Olivo
382 Springfield Avenue
Summit, NJ 07901

EXAMINER

LE, THIEN MINH

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/769,144

Applicant(s)

RATHUS ET AL.

Examin r

Thien M. Le

Art Unit

2876

-- The MAILING DATE f this communicati n appears on the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 262-362 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 262-362 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on 4/23/2003 has been entered. Claims 1-262 have been canceled. Claims 262-362 remain for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 262-362 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (Gupta – 5,382,779; newly cited) in view of Schlafly (Schlafly – 4,734,858; newly cited) and the general teachings of the prior art of record, [in particular Konishi – 5,237,156; Younger – 5,151,687; Ishii – 5,148,297].

Gupta discloses a shelf price label verification apparatus and method. According to Gupta, the scan routine (43) is started when the employee takes the verification unit out into the store to begin scanning. The employee scans a shelf-price label (44) pressing the trigger switch (16) on the wand (15) or gun. This causes the scanning means to read the label, and the UPC (22) and price (23) from the label are decoded by the CPU and loaded into the RAM (37). The CPU then uses the UPC as a key to look up (retrieve) an item record (45) in the database on the disk (35). If the item record is not found (46), the CPU will cause the display to show an appropriate message ("ITEM NOT FOUND") and preferably to emit an audible warning. The routine then falls through to the bottom, where it checks to see if the "done" switch was pressed. If not, it returns to the top and waits for another scan.

Gupta further discloses that if the item record was found (46), the CPU then (48) compares the price scanned from the label (23) to the price from the item record retrieved from the database stored on disk (35). If the comparison indicates that the price is correct, the CPU displays a message to that effect (49). ("PRICE OK"),

optionally gives an audible indication, and falls through to the check of the "done" indication (52), as described above.

According to Gupta, it is not necessary for the data base to reside in the verification unit, though this is preferred. If desired, the "disk" in the verification unit can be eliminated, and the "I/O" link (34) in FIG. 3 between the verification unit (30) and the store computer (60) would become a remote link, using whatever radio (RF) or infrared (IR) technology is current at the time. For example, the "wireless LAN modem" technology could be used to establish the link, or a duplex simultaneous transmission/reception path on one or more frequencies could be used with conventional 4-wire modems. The operation of the invention would not change, except that the "download database" step (42) of FIG. 4 would not be needed, and the lookup would actually be performed in the store's computer database via the remote link.

As can be seen, Gupta discloses the means and method for scanning, transmitting and retrieving information from a machine recognizable bar code. The claim differs in calling for the step of scanning the bar code from a catalog. However, this claimed limitation is not new. Reference to Schlafly is cited as evidence showing the step of scanning a product code such as a bar code 158 from a catalog 82 for a product ordering system. Specifically, figures 4-5 of Schlafly shows the catalogs containing the bar codes. Schlafly system includes a light pen, a transmitter 152, a display 68, a processor 130, a keyboard 66, and a memory 132. It would have been obvious to incorporate the step of scanning a product code from a catalog in the system as taught by Gupta. The modification allows the user to perform price check

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for the product that is printed in the catalog and compares with the price obtained from the products on the shelves.

Regarding claim 263, Gupta discloses that remote link, i.e. radio (RF) or infrared (IR) technology is current at the time can be used in his system. Gupta also mentions the use of modem for communicating with a remote device. Accordingly, the use of the Internet is considered inherent or an intended communication link.

Regarding claim 264, Gupta discloses the use of the bar codes which would embraces all limitations set forth in this claim.

Regarding claim 265, see the discussions set forth above.

Regarding claim 267, see the discussions above.

Regarding claim 268, see the discussions above.

Regarding claim 269, see the discussions above.

Regarding claims 266, 270-362, see the discussions above. Though Gupta discloses the use of a bar code, he is silent about the use of other form of code such as a watermark, an invisible barcode, a magnetic code, a printer character, a invisible icon, etc. Official Notice is taken that the use of a watermark, a magnetic code, a printed character, an icon, etc., as a data input source are notoriously well known and old. Without any specific and unexpected result, replacing one source of input with another known source of input would have been design consideration; and would have not been considered novel. Further, references to Konishi and Younger are cited as evidence showing the interchangeability of one type of coding media with another.

Specifically, Konishi discloses a scanner for scanning bar codes, magnetic characters or OCR.

Younger acknowledges several methods of identifying media-taped material subject category, including descriptive words, mnemonics, numeric codes, abbreviations, symbols, or icons.

The claims also differ in calling for various different communication links. It would have been obvious to use one communication link in place of another. Though not all types of communication links as recited in the claims are mentioned by Gupta, it would have been obvious in light of his teachings of using alternative communication links such as RF, IR, WAN, etc. Thus, the modifications are well within the skill levels and expectations of an ordinary skilled artisan; and are not considered novel.

The claims also differ in calling for the use of various type of display device, i.e. lap top, computer, paper, telephone, book, intelligent terminal, television, etc. Though Withmall discloses the use of a display device, he is silent about the use of alternative displaying devices. Official Notice is taken that the use of a television, a pager, a lap top, a computer, a telephone, a book, etc. for displaying content messages to a user is notoriously old and known. Without any specific and unexpected result, replacing one type of display with another type of display would merely has been a substitution of an art recognized equivalent; which does not enhance the underlying inventiveness concepts of the disclosed invention; and thus is not considered novel. Further, references to are cited as evidence showing the interchangeability of one type of display with another type of display.

Specifically, Ishii discloses a LCD which can be incorporated in a TV, a game, a lap top, an information processing apparatus, or a projection type visual/information apparatus.

The claims differ in calling for the use of various type of code recognition device such as a scanner, a digital mouse, a digital camera, an optical reader, a computer, a television, etc. Though Gupta discloses the use of a bar code reader, he is silent about the use of alternative displaying devices. Official Notice is taken that the use of a scanner, a digital mouse, a digital camera, an optical reader, a computer, a television, etc. for recognizing encoded information are notoriously known and old. Without any specific and unexpected result, replacing one type of feature recognition device another type would merely has been a substitution of an art recognized equivalent; which does not enhance the underlying inventiveness concepts of the disclosed invention; and thus is not considered novel.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-

3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Le, Thien Minh
Primary Examiner
Art Unit 2876
June 30, 2003